

IN THE DRAWINGS:

A replacement sheet is submitted for FIG. 3, showing the controller 116.

REMARKS

The Office Action dated April 19, 2006 has been reviewed and carefully considered. Claims 14-20 are added, claims 1 and 16 being the independent claims. Claims 1-5, 7- 9 and 11-13 are amended. Reconsideration of the above-identified application, as amended and in view of the following remarks, is respectfully requested.

A telephonic interview was held on July 14, 2006 between Examiner John M. Hoffmann and Attorney David J. Rosenblum, on behalf of Samsung Electronics Company, Ltd., regarding the above-identified patent application. As per their prior agreement, a copy of the proposed amendment and an English-translated copy of the priority document were submitted to the Examiner the previous day.

Regarding correction of the specification based on the priority document incorporated by reference, the Examiner responded affirmatively that no objections are noted at this time.

The Examiner was asked whether the formal rejections under 35 U.S.C. 101 and 112 are to be sustained or withdrawn in view of the substantial claim amendments proposed. The Examiner noted that the Examiner has not yet looked into it closely but does not notice, at this point, any language in claim 1 that warrants formal rejection.

The Examiner indicated the intention to further search the prior art, due to the substantial claim changes proposed.

The Examiner pointed out that the Office Action, when filed, should state that the arguments set forth with regard to claims 1, 9 and 13 apply to new, independent claim 16. Accordingly, this statement appears below for claim 16.

As the Examiner noted in our phone conversation arranging for the interview, our sending of the English translation of the priority document in preparation for the interview does not constitute a formal submission to the Patent Office.

The applicant accordingly now submits, enclosed with the instant reply, a certified copy of an English-language translation of the Korean priority document.

We note, at the outset, that there are slight formatting differences between this document and the one informally submitted in preparation for the telephonic interview. The latter document is, despite slight reformatting, informally regarded as "the priority document," although we realized after our telephonic interview that the certified translation may be formatted slightly differently.

However, the operative language, in terms of our argument, is the same in both documents. For precision in reference to an exact translation of the Korean priority document, we revise our proposed amendment herein below to cite to the enclosed, exact English translation.

Claims 1-13 stand rejected under 35 U.S.C. 101 as directed to non-statutory subject matter.

Claim 1 is now amended in a manner that is believed to overcome the instant ground of rejection.

Support for the amendment of claim 1 is found in the specification (see [0012], last sentence in [0030], [0038], [0039]; see also [0027], third and fourth sentences, [0001], incorporating by reference the priority document and, in the priority document, i.e., the certified translation, the sentence bridging pages 4 and 5, the sentence bridging pages 5 and 6, and the following sentence on page 6).

In [0027], the fourth sentence seems to contradict the third sentence, unless the entirety of the originally filed patent application is available for interpreting the seeming contradiction. The entirety includes the Korean priority document, which is incorporated by reference.

Where a foreign priority document under 35 U.S.C. 119 is of record in the U.S. application file, applicant may not rely on the disclosure of that document to support correction of an error in the pending U.S. application. *Ex parte Bandeau*, 132 USPQ 356 (Bd. App. 1961). This prohibition applies regardless of the language of the foreign priority documents because a claim for priority is simply a claim for the benefit of an earlier filing date for subject matter that is common to two or more applications, and does not serve to incorporate the content of the priority document in the application in which the claim for priority is made. This prohibition does not apply where the U.S. application explicitly incorporates the foreign priority document by reference. >For applications filed on or after September 21, 2004, where all or a portion of the specification or drawing(s) is inadvertently omitted from the U.S. application, a claim under 37 CFR 1.55 for priority of a prior-filed foreign application that is present on the filing date of the application is considered an incorporation by reference of the prior-filed foreign application as to the inadvertently omitted portion of the specification or drawing(s), subject to the conditions and requirements of 37 CFR 1.57(a). See 37 CFR 1.57(a) and MPEP § 201.17. MPEP 2163.07(II).

Two passages of the Korean priority document are cited above, the sentence bridging pages 4 and 5, the sentence bridging pages 5 and 6, and the following sentence on page 6.

The first passage states that "known functions and configurations" incorporated herein are omitted for clarity of presentation, i.e., "omitted when it may make the subject matter of the present invention unclear."

The second passage states, "For convenience of description, a means for automatically opening, closing, and controlling the cooling apparatus is not shown because this may make the subject matter of the present invention unclear."

The priority document, and therefore the present application which incorporates the priority document, is saying the following: the addition, to the embodiment shown in FIGs. 3 and 4 in the context of its description in the specification, of "means for automatically opening, closing and controlling" constitutes the addition of a known function or configuration (priority document, page 4, line 38), and detailed description of the means is therefore omitted.

Conversely, the present patent application makes no judgment on the addition of such means to any conceivable embodiment other than that shown in FIGs. 3 and 4 and described in the specification.

Finally, the applicants note that claim 1, as amended, is clearly an apparatus.

For at least the above reasons, the instant applicants respectfully submit that claim 1, as amended, now overcomes the instant ground of rejection under 35 U.S.C. 101.

Claims 1-13 stand rejected under 35 U.S.C. 112, first paragraph, for failing to comply with the written description requirement.

The issue of a generator being activated is addressed by amendment of the claims.

More generally, as to the current amendments, the applicants note:

An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction. *In re Odd*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971).

The present applicants submit that the overall meaning of the above-quoted passages in the present application, including its incorporated priority document, would have been clear to one skilled in the art. It accordingly would be proper to rewrite [0027] in the specification to reflect the incorporated disclosure from the priority application. The specification is amended accordingly.

FIG. 3, as now amended, shows, as "means for automatically opening, closing, and controlling the cooling apparatus" ([0027], fourth sentence), a controller.

The present applicants further note:

The description of an apparatus with block diagrams describing the function, but not the structure, of the apparatus is not fatal under the enablement requirement of 35 U.S.C. 112, first paragraph, as long as the structure is conventional and can be determined without an undue amount of experimentation. *In re Ghiron*, 442 F.2d 985, 991, 169 USPQ 723, 727 (CCPA 1971); MPEP 2185.

Since, in the context of FIGs. 3 and 4 of the present patent application and the accompanying description in the specification, the structure of the controller is conventional (see priority document, the sentence bridging pages 4 and 5, the sentence bridging pages 5 and 6, and the following sentence on page 6), the controller and the

above-recited means are properly claimed in new claim 15 and in claim 1 as amended, respectively.

As discussed above, it is submitted that the claims, as now amended, overcome the instant ground of rejection.

Claims 1-13 stand rejected under 35 U.S.C. 112, second paragraph, as indefinite, based on the issue of method steps in an apparatus claim, and based claim-by-claim on particular reasons.

The issue of method steps in an apparatus claims has been addressed by the instant amendment, as discussed above. The claim-by-claim issues are also addressed by amendment.

As to this ground of rejection as well, it is submitted that the claims, as now amended, overcome the instant ground of rejection.

The specification stands objected to for lack of antecedent basis for the claimed subject matter.

Based on the claims as now amended, it is submitted that proper antecedent basis in the specification for the claimed subject matter exists.

As to the current amendment of the specification, it finds support in the specification at the same portions cited above with regard to the amendment of claim 1.

The drawings stand objected to under 37 CFR 1.83(a) for failing to show the "stacked structure."

Since claim 3 is amended to no longer recite "stacked structure," the instant ground of objection is believed to be rendered moot.

The amendment of FIG. 3 to show the controller finds support in the specification in the same portions cited above with regard to the amendment of claim 1.

Claims 1-3, 8 and 10-12 stand rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 4,966,615 to Linden et al. ("Linden") in view of U.S. Patent No. 5,568,728 to Sapsford.

As the Office Action acknowledges, Linden fails to disclose the left cooling body part and the right cooling body part.

Sapsford features clamps 24 for holding strips 18, 21 together.

However, the open state merely serves to facilitate the initial threading of the optical fiber. Once the threading is completed, the strips 18, 21 are clamped together into a closed state (col. 4, lines 11-20).

By contrast, the present claim 1, as amended, recites, ". . . said apparatus being configured for, based on a current drawing speed of the drawn optical fiber, automatically operating said cooling body to transition said parts from said separated to said joined state. . ."

For at least the above reasons, claim 1 as amended is deemed to distinguish patentably over Linden and Sapsford.

Claims 9 and 13 stand rejected under 35 U.S.C. 103(a) as unpatentable over Linden in view of Sapsford and Japanese Patent Publication No. 06-219789 to Hisashi et al. ("Hisashi").

Support for the amendment of claim 13 is found at least in FIG. 5 and accompanying text in the specification.

Claims 9 and 13 depend from base claim 1. Hisashi relates to turbulence generation, but cannot make up for the shortcomings of the other two references.

Likewise, U.S. Patent Publication to Ghani et al. ("Ghani") relates to counter-flow in a coolant stream, but cannot compensate for the shortcomings of the other references.

Each of the other rejected claims depends from base claim 1 and is deemed to distinguish patentably over the prior art of record at least due to its dependency.

New claims 14 and 19 find support in the specification, at least at [0029].

New claims 15, 17 and 18 find support at least at [0038].

New claim 16 finds support at least in the same areas of the disclosure as those cited above with regard to claim 1.

Claim 16 includes the feature of transitioning based on the drawing speed and is accordingly likewise deemed to distinguish over the prior art of record for at least the same reasons set forth above with regard to claims 1, 9 and 13.


New claim 20 finds support at least at [0039].

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited reference. A notice of Allowance is respectfully requested.

Should the Examiner deem that there are any issues, which may be best, resolved by telephone communication, please contact Applicant's undersigned Attorney at the number listed below.

Respectfully submitted,

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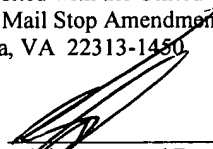
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